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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/078,830	02/19/2002	William Goggin	TOK00-034	6585
22855	7590	03/23/2004	EXAMINER	
RANDALL J. KNUTH P.C. 3510-A STELLHORN ROAD FORT WAYNE, IN 46815-4631			SHAPIRO, JEFFREY A	
			ART UNIT	PAPER NUMBER

3653

DATE MAILED: 03/23/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/078,830

Applicant(s)

GOGGIN ET AL.

Examiner

Jeffrey A. Shapiro

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*MA*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 07 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nicholas et al. Nicholas et al discloses the following.

As described in Claims 1, 5, 13 and 14;

1. generating test data relating to a fuel dispenser (see abstract);
2. storing the test data in a nonvolatile memory (24) within said fuel dispenser (see col. 7, lines 26-29);
- 2a. a controller (15 or 22);

As described in Claims 2 and 15;

3. printing the test data (26);

As described in Claims 3 and 16;

4. transmitting the test data to a remote location (21 and 33);

As described in Claim 4;

5. the generated test data is diagnostic test data (see figures 7-11 and col. 12, lines 35-39);

As described in Claims 6 and 12;

6. said nonvolatile storage means is at least one of EPROM, EEPROM, flash memory, hard drive and NVRAM (see col. 7, lines 36-46);

As described in Claim 7;

7. the fuel dispenser has a display (see col. 7, lines 15-17);

As described in Claim 8;

8. the fuel dispenser comprises a signal receiving device (see figure 3, dispenser interface module (44);

As described in Claim 9;

9. an interface means for connecting to a testing device (42);

As described in Claim 10;

10. a printer for printing test data (26);

As described in Claim 11;

11. a transmitting means for transmitting test data to a remote location (21);

As described in Claims 17 and 18;

12. a switch means for activating the retrieval of the test data and displaying the test data on said display or printing the test data (15 or 52);

At the time of the invention it would have been obvious to one of ordinary skill in the art to have contained all of the components of the system of Nicholas into a single housing. It is noted that this is considered a functional equivalent of Applicant's system, which combines all of said components into one housing. Further, it can be argued that

Applicant's claim language which states that the components are inside the fuel dispenser is met if one construes the entire system of Nicholas as a fuel dispenser, or a fuel dispenser system. A dispenser has something which contains the items or liquid to be dispensed, such as a tank, and also has control circuitry and software connected to it in order to operate it and run test or diagnostic routines on the system. Therefore, it would have been obvious to obtain the invention as described in Claims 1-18 by the teachings and disclosure of Nicholas.

3. Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Terranova et al (US 6,112,134) in view of Clarke (US 5,569,922). Terranova discloses the following.

As described in Claims 1, 5, 13 and 14;

1. generating test data relating to a fuel dispenser (see figures 2 and 3, noting test step (26), and col. 6, lines 4-48);
2. storing the test data in a nonvolatile memory (see col. 7, lines 5-12 and 33-42) within said fuel dispenser;
  - 2a. a controller (350);

As described in Claims 3 and 16;

4. transmitting the test data to a remote location (see col. 7, lines 33-42);

As described in Claim 4;

5. the generated test data is diagnostic test data (see figures 2, 3 and col. 6, lines 4-9);

As described in Claims 6 and 12;

6. said nonvolatile storage means is at least one of EPROM, EEPROM, flash memory, hard drive and NVRAM (see col. 7, lines 33-36, which describes storage in several memory devices which can be considered functional equivalents of the recited memory devices—see also Terranova Claim 26, col. 10, lines 20-29);

(Note also Sinha et al (US 5,606,130), incorporated by reference in Terranova at col. 3, lines 19-21. Figure 1 of Sinha illustrates a computer (22) with disc drives and hard drives for controlling and interacting with octane rating monitoring equipment/sensors. See also col. 3, line 67 and col. 4, lines 2-3.)

As described in Claim 7;

7. the fuel dispenser has a display (351, 352);

As described in Claim 8;

8. the fuel dispenser comprises a signal receiving device (see Terranova Claim 26, col. 10, lines 20-23);

As described in Claim 9;

9. an interface means for connecting to a testing device (42);

As described in Claim 11;

11. a transmitting means for transmitting test data to a remote location  
(see col. 7, lines 33-42);

As described in Claims 17 and 18;

12. a switch means for activating the retrieval of the test data and  
displaying the test data on said display or printing the test data (note that  
the dispenser electronics (350) have electronic switches in the form of  
logic switches either constructed within control software or the circuitry  
itself);

Terranova does not expressly disclose, but Clarke discloses the following.

As described in Claims 2 and 15;

3. printing the test data;

As described in Claim 10;

10. a printer for printing test data;

(See col. 2, lines 5-10, in which Clarke states that "fuel related problems can then be identified and diagnosed...and the diagnosis can be immediately displayed for the operator." Clarke further states that "[t]he term 'display', as used herein, describes a transient visual display as well as other more permanent records, such as hard copy print outs.")

Both Terranova and Clarke are considered to be analogous art because  
Terranova discloses a system of fuel dispensing with monitoring/testing/diagnosis

routines and Clarke discloses a fuel analyzer which for diagnosis of fuel-related problems in an automobile.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have caused the octane testing output from various parts of the system to be printed in addition to being displayed in displays (351, 352).

The suggestion/motivation would have been to help an operator diagnose octane mixing problems with the fuel dispenser as well as to help maintain mandated inspections by governmental authorities. See Clarke, col. 2, lines 5-10 and Terranova, col. 7, lines 15-17 and 33-42.

Therefore, it would have been obvious to combine Terranova and Clarke to obtain the invention as described in Claims 1-18.

#### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1-18 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1-41 of U.S. Patent No.



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6,470,288. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims recite generating test data relating to a fuel dispenser and storing the test data in a memory within said fuel dispenser, or a functional equivalent thereof.

### ***Response to Arguments***

6. Applicant's arguments filed 1/7/04 have been fully considered but they are not persuasive. Nicholas discloses a fuel dispenser monitoring/diagnosis system with structure, function and results substantially the same as Applicant's system. Applicant's admit that the basic components of Nicholas in fact function as Applicant's basic components. Applicant's assert that Nicholas differs from the claimed subject matter because it does not include such components within the fuel dispenser itself, but remotely from the system. However, it can be construed that the fuel dispenser system includes the tank, the site controller, and the dispenser controller, for example. As such, the system of Nicholas performs substantially functions, with substantially the same results, and substantially the same structure as Applicant's system. Simply placing all components into one housing is not considered to significantly affect the operation of such a system. Terranova, cited above, also appears to read on Applicant's claims, as currently written, and reasonably, broadly construed. Therefore, Claims 1-18 are rejected.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is

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(703)308-3423. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jeffrey A. Shapiro  
Examiner  
Art Unit 3653

March 16, 2004



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